

REMARKS

Claims 7 and 20 are amended. Claim 24 is newly added. Claim 23 is cancelled. Claims 1-3, 5-22, and 24 are now pending in the application. The amendments to the claims as indicated herein do not add any new matter to this application. Each issue raised in the Office Action mailed October 27, 2008 is addressed hereinafter.

I. ISSUES NOT RELATING TO PRIOR ART

A. CLAIM 20

Claim 20 is rejected under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter. This rejection is respectfully traversed. The Office Action (pages 2-3) asserts that “Claim 20 is considered software per se” and contends that “Where there is not evidence in the specification that a means which may be interpreted as software, hardware or combinations thereof necessarily includes hardware, it will be interpreted in its broadest reasonable sense as software means, which is the case here.” This is incorrect. The Office Action cites no law, rule, or case decision establishing Claim 20 is not software per se. Applicants are unaware of any legal requirement supporting the idea that “evidence in the specification that a means which may be interpreted as software, hardware or combinations thereof necessarily includes hardware.” Moreover, for example, paragraph [0101] of Applicants’ specification states that “hard-wired circuitry may be used in place of or in combination with software instructions to implement the invention. Thus, embodiments of the invention are not limited to any specific combination of hardware circuitry and software”.

Present Claim 20 recites “one or more processors.” Support for this amendment can be found at least within paragraphs [0098] and [0100] of Applicants’ specification. In view of the amendment, claim 20 is not properly interpreted as limited to “software per se.” Reconsideration is respectfully requested.

B. CLAIM 24

Claim 24 is new. Support is found at least in paragraph 0091 of the specification.

II. ISSUES RELATING TO PRIOR ART

A. CLAIMS 1-3, 5-14, 16, 18-21 AND 23—DELL, HELGREN AND DOMINI

Claims 1-3, 5-14, 16, 18-21 and 23 are rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Kyon Holman (Dell OpenManage Network Manager, Nov. 17, 2003) in view of Helgren et al (US Patent 7,051,243 B2) in further view of Domini et al (US Patent 6,085,2063) in further view of Ames et al (US Patent 6,151,567). The rejection is respectfully traversed.

Claim 1 recites in part: **“displaying the comparison information including displaying parameters of the first configuration that do not conform with the parameters of the second configuration; choosing one or more action mechanisms to display to the user for each of the one or more parameters based on the comparison information including the non-conforming parameters; ...”** (emphasis added). In rejecting this portion Claim 1, the Office Action (page 4) relies on portions of columns 2 and 13 of Helgren. Applicant respectfully disagrees.

Helgren describes a rules engine 150 which evaluates configuration data against rules data. Rules data can include information about a specific potential problem of a component, versions of software patches and updates that may be available for one or more components, recommendations for language to be included in identifiers, step-by-step actions, and recommendations for eliminating the problem (Helgren, column 4). Rules data may be specified using any language. Rules are evaluated to a Boolean result based on predicate and operator Boolean values, resulting in a pass/fail determination for a particular set of rules (Helgren, col. 13, lines 37-42; col. 15, lines 12-14). Rules can fail because the rules are not suitable or helpful to a user, and it is then possible to edit or alter the rules to make them useful. Conversely, if the rules “pass”, they can be stored in a database for potential later use.

Thus, Helgren does not display comparison information of a first configuration that does not conform with a second configuration, as claimed. Within Helgren, there is no “second configuration”. Instead, Helgren runs the “rules” against a first configuration.

Helgren also contains no equivalent for the claimed step of **“displaying the comparison information including displaying parameters of the first configuration that do not conform with the parameters of the second configuration.”** In Helgren, the first configuration is not changed; therefore, Helgren fails to disclose the claimed step of “applying changes to the first configuration information”. Instead, Helgren’s “rules” may be changed, or some rules may be designated “inapplicable” (column 9).

Further, Helgren’s true/false results of rule processing might yield recommendations or notes for solving a specific problem (column 5, lines 37-38), installing an update software component or “patch” (column 5, various), generating an e-mail that is sent to a distribution list of potential interested parties (column 5, lines 44-47), or storing the results in a database (column 13, bottom). However, Helgren does not provide “display parameters of a first configuration that do not conform with the parameters of a second configuration”, as claimed.

For at least the above reasons, the rejections of Claims 1 and 16-22, and claims depending on any of claims 1 or 16-22, are unworkable.

Domini does not cure the foregoing deficiencies of Helgren. In rejecting the portion of the claim which reads “choosing one or more action mechanisms to display to the user for each of the one or more parameters based on the comparison information including the non-conforming parameters”, the Office Action (page 4) relies on Domini columns 1, 12 and 13. This is incorrect.

Domini discloses software which performs spell-checking and grammar-checking on text documents. However, Domini’s text documents do not correspond to the claimed “configuration parameters based on comparison information” because Domini’s text documents do not contain configuration information. Instead, Domini’s text documents are subject to editing within word processing software and may contain “dirty text”, that is, text that could be improved with either spell-checking or grammar checking (column 9, lines 45-55).

The Office Action asserts that Domini’s suggested spellings correspond to the claimed “non-conforming parameters”. This is incorrect. A non-conforming parameter exists when a

first configuration has parameters that differ from parameters from a second configuration.

Domini's "dirty text" does not correspond to configuration files or parameters.

The Office Action asserts no evidence why a person of ordinary skill in the art would modify Dell with the spell-checking of Domini to achieve the claimed steps. Even if Domini is combined with Dell, the combination would merely provide for spell-checking a single configuration—not comparing **two configurations** and identifying non-conforming parameters.

Dell describes a user entering text that could be spell-checked. For example, Dell's FIG. 10, cited within the Office Action (page 3), shows a window on the left that has a misspelled word "defautl". In Dell's FIG. 5, a user is prompted to enter a "name" and a "description". The suggested combination of Domini with Dell might be useful for spell-checking the name and description text entered by a user. However, such a combination fails to teach or suggest the claimed step of "choosing one or more action mechanisms to display to the user for each of the one or more parameters based on the comparison information."

Indeed, the combination **teaches away** from the claims. Domini only operates on text entered by a user, while many of the parameters of Dell were not entered by a user, are displayed for a read-only purpose, and are thus not alterable or changeable. The only parts of Dell that could be altered by Domini are the user-entered text portions, which would not include the claimed "each of the one or more parameters". Thus, the combination of Domini with Dell would not achieve the claimed step of "choosing one or more action mechanisms to display to the user for each of the one or more parameters based on the comparison information."

The Supreme Court of the United States recently ruled that a rejection under 35 U.S.C. 103 requires the clear articulation of the reasons why the claimed invention would have been obvious. "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR International Co. v. Teleflex, Inc.*, 550 U.S. ___, 82 USPQ2d 1385, 1396 (2007). The rejection of Claim 1 is not supported by the kind of rational evidentiary underpinning required by *KSR*. There is no suggestion or motivation to combine

Domini with Dell in the references or any other evidence of record, and the proposed combination would not result in the claimed method.

For at least the above reasons, the rejection of Claims 1 and 16-22 are unupportable and should be withdrawn. Similarly, the rejections of all claims dependent therefrom are also unupportable and should be withdrawn.

B. CLAIMS 7, 24—CONFIGURATION CHECKING FEATURES

Claim 7 now recites “checking the new configuration against an object model of acceptable configurations, wherein the object model comprises the constraints of each parameter in the configuration, the interrelations among those parameters, and how they relate as a whole to the device being configured; if the changes are not acceptable, displaying a summary of problems”. Support for this amendment can be found at least within paragraph [0091] of Applicants’ specification. Newly added Claim 24 also recites this feature.

In rejecting Claim 7, the Office Action relies upon Helgren’s column 5, lines 11-26. Applicant respectfully disagrees. The cited sections describe incorporating a recommended configuration within Helgren’s rules. The recommended configuration may be derived based on past knowledge of a configuration. However, Helgren does not state that any of the parameters or other data within the recommended configuration are evaluated based on their interrelations with each other or to a particular device as a whole. Thus, the claimed feature of checking the “constraints of each parameter in the configuration, the interrelations among those parameters, and how they relate as a whole to the device being configured” is not met by Helgren’s recommended configuration.

For at least the above reasons, the rejection of Claim 7 is unupportable and should be withdrawn.

C. ALL OTHER CLAIMS

All remaining Claims were rejected under 35 U.S.C. § 103 as allegedly obvious over a variety of references using Dell, Helgren, and Domini as base references. However, all of these Claims either explicitly recite or depend from other Claims which recite elements or steps which

as shown above are neither disclosed nor suggested by any combination of prior art, either by Dell, Helgren, Domini, or by any other reference. The secondary references do not cure this deficiency of Dell, Helgren, and Domini, and therefore any combination of Dell, Helgren, and Domini with any of the secondary references cannot provide the complete combination of features recited in the remaining claims.

III. CONCLUSIONS & MISCELLANEOUS

For the reasons set forth above, all of the pending claims are now in condition for allowance. The Examiner is respectfully requested to contact the undersigned by telephone or e-mail relating to any issue that would advance examination of the present application. As per MPEP Chapter 5, Applicant acknowledges that Internet communications may not be secure.

A petition for extension of time, to the extent necessary to make this reply timely filed, is hereby made. If applicable, a check for the petition for extension of time fee and other applicable fees is enclosed herewith. If any applicable fee is missing or insufficient, throughout the pendency of this application, the Commissioner is hereby authorized to charge any applicable fees and to credit any overpayments to our Deposit Account No. 50-1302.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER LLP

/christophertanner#41518/

Dated: December 30, 2008

Christopher M. Tanner
Reg. No. 41, 518

ctanner@hptb-law.com
2055 Gateway Place Suite 550
San Jose, California 95110-1093
Telephone No.: (408) 414-1238
Facsimile No.: (408) 414-1076